

REMARKS

INTRODUCTION:

In accordance with the foregoing, claims 1-6, 11-14, 16, and 26-41 have been canceled without prejudice or disclaimer, claims 43-49 have been added. Claims 7, 9, 10, 15, 18, 19, 21, 22, and 42 have been made independent, and have not been amended to narrow the scope of the claims. No new matter is being presented, and approval and entry are respectfully requested.

Claims 7-10, 15, 18-25, and 42-49 are under consideration. Reconsideration is requested.

REJECTION UNDER 35 U.S.C. §103:

In the Office Action at pages 3-11, the Examiner rejects claims 1-16 and 18-42 under 35 U.S.C. §103 in view of Uranaka (U.S. Patent No. 5,937,158) and Toyama et al. (Japanese Patent Publication No. 07-295,998). The rejection is respectfully traversed and reconsideration is requested.

As a point of clarification, claims 1-6, 11-14, 16, and 26-41 have been canceled without prejudice or disclaimer. As such, it is respectfully submitted that the rejection of these claims is deemed moot.

In general, in order to reject a claim under 35 U.S.C. §103, a reference must be provided which discloses each element of the claim in the manner recited in the claim. In interpreting the reference, the Examiner is to broadly interpret the claim, but must do so within the bounds of reason. In re Morris, USPQ2d 1023, 1027-28 (Fed. Cir. 1997), MPEP 2131 and 2111. Thus, while the Examiner is to avoid reading limitations from the specification into the claims, the Examiner should not interpret claim limitations so broadly as to contradict or otherwise render a limitation meaningless as would be understood by those of ordinary skill in the art. See, In re Cortright, 49 USPQ2d 1464, 1467 (Fed. Cir. 1999), In re Zletz, 13 USPQ2d 1320, 1322 (Fed. Cir. 1989), MPEP 2111.01.

A. The combination of Uranaka and Toyama et al. does not disclose or suggest distinguishing original and updated portions of display

By way of review, claim 7 recites, among other features, "during said displaying of the commodity catalog information, the commodity catalog information is marked so that an updated portion and a non-updated portion are distinguished from each other."

In contrast, Uranaka teaches displaying the contents of the electronic catalog DVD 1200. Where items have been purchased in the past, the purchase history retrieved from the purchase history information storage area 1203 is used by a catalog shopping server 1220 to determine a priority order in which the contents of the electronic catalog DVD 1200 are displayed at the catalog shopping client 1210. By way of example, Uranaka teaches using a script by which categories of commodities of interest based on the purchase history are displayed with an image, whereas those categories of less interest are displayed only using text. (Col. 19, lines 8-15 and 22-34; operations 1402, 1403 of Uranaka). However, there is no suggestion in Uranaka that the display indicates which items being sold have updated information as compared to the information included on the DVD 1200.

On page 6 of the Office Action, the Examiner clarifies that, since Uranaka suggests displaying items ranked higher in terms of user preference using past purchase history and displaying items which have already been ordered in the past versus items not yet ordered, it would have been obvious to incorporate "one further display difference" so as to encompass the display methods recited in claim 7. As no support exists in Uranaka or Toyama et al. to support the Examiner's "one further display difference," and since the Examiner clarifies on page 3 of the Office Action that the Examiner is not taking official notice of such a feature, there is insufficient evidence of record as to the existence of each feature of claim 7 is disclosed by the combination of Uranaka and Toyama et al.

Additionally, there is no evidence of record as to why one of ordinary skill in the art would have been motivated to incorporate such a change into the combination of Uranaka and Toyama et al. Therefore, there is insufficient evidence of record as to the existence of both each feature

of claim 7 and a motivation to combine the missing feature in the combination as is to maintain a prima facie obviousness rejection of claim 7 under 35 U.S.C. §103.

For similar reasons, it is respectfully submitted that the combination of Uranaka and Toyama et al. does not disclose or suggest the invention recited in claim 21.

Claims 24 and 25 are deemed patentable due at least to their depending from claim 21.

B. The combination of Uranaka and Toyama et al. does not disclose or suggest distinguishing original and updated portions of display based on colors

By way of review, claim 8 recites, among other features, "during said displaying of the commodity catalog information, the commodity catalog information is marked so that an updated portion and a non-updated portion are distinguished from each other," where "the updated portion and the non-updated portion are marked with different colors."

In contrast and as noted above in Section A, Uranaka teaches displaying the contents of the electronic catalog DVD 1200 based on the purchase history information read from the storage area 1203, which is used by a catalog shopping server 1220 to determine a priority order and a format in which the contents of the electronic catalog DVD 1200 are displayed at the catalog shopping client 1210. However, there is no assertion in Uranaka that the display indicates which items being sold have updated information using different colors as compared to the information included on the DVD 1200.

On page 6 of the Office Action, the Examiner clarifies that, since Uranaka suggests displaying items ranked higher in terms of user preference using past purchase history and displaying items which have already been ordered in the past versus items not yet ordered, it would have been obvious to incorporate "one further display difference" so as to encompass the display methods recited in claim 8. As no support exists in Uranaka or Toyama et al. to support the Examiner's "one further display difference," and since the Examiner clarifies on page 3 of the Office Action that the Examiner is not taking official notice of such a feature, there is insufficient

evidence of record as to the existence of each feature of claim 8 is disclosed by the combination of Uranaka and Toyama et al.

Additionally, there is no evidence of record as to why one of ordinary skill in the art would have been motivated to incorporate such a change into the combination of Uranaka and Toyama et al. Therefore, there is insufficient evidence of record as to the existence of both each feature of claim 8 and a motivation to combine the additional missing feature in the combination as is to maintain a prima facie obviousness rejection of claim 8 under 35 U.S.C. §103.

C. The combination of Uranaka and Toyama et al. does not disclose or suggest writing catalog information to a write once area

By way of review, claim 15 recites, among other features, "a writeable area in which updated commodity catalog information is written when provided by a server," where "said writeable area comprises an area to which information is written once, and is thereafter a read only area."

In contrast, Uranaka teaches displaying writing the purchase history to a rewritable DVD 1200. (Col. 17, lines 20-37 of Uranaka). Additionally, Toyama et al. is not relied upon as curing and does not cure this deficiency. As such, while the Examiner asserts on page 8 of the Office Action, without support in Uranaka, that the media utilization information 1300 shown in FIG. 16 is written in an area which will be written once and readable only thereafter, there is no disclosure in that the rewriteable DVD 1200 has a write once section. Thus, it is respectfully submitted that the combination of Uranaka and Toyama et al. does not disclose or suggest the invention recited in claim 15.

For similar reasons, it is respectfully submitted that the combination of Uranaka and Toyama et al. does not disclose or suggest the invention recited in claim 18.

D. The combination of Uranaka and Toyama et al. does not disclose or suggest writing catalog information to a writable area having a write once area and a rewritable area

By way of review, claim 42 recites, among other features, that "said writeable area comprises a write once area to which data can be written once; and a rewriteable area to which

data can be repeatedly written and/or from which data can be erased."

In contrast and as similarly noted above in Section C, Uranaka teaches displaying writing the purchase history to a rewritable DVD 1200. (Col. 17, lines 20-37 of Uranaka). Uranaka does not suggest that the rewritable area is included in addition to a write once area. Additionally, Toyama et al. is not relied upon as curing and does not cure this deficiency. As such, while the Examiner asserts on page 8 of the Office Action, without support in Uranaka, that the media utilization information 1300 shown in FIG. 16 is written in an area which will be written once and readable only thereafter, there is no disclosure in that the rewriteable DVD 1200 has a write once section. Thus, it is respectfully submitted that the combination of Uranaka and Toyama et al. does not disclose or suggest the invention recited in claim 42.

Claims 9, 10, 19, 20, 22, and 23 are deemed patentable due at least to their depending from corresponding claims 7 and 18.

PATENTABILITY OF NEW CLAIMS:

Claims 43-49 are deemed patentable due at least to their depending from claim 42.

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

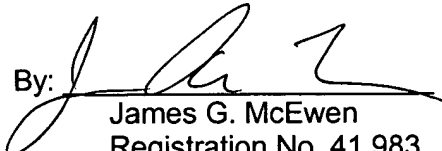
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If there are any additional fees associated with the filing of this Response, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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